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Application No.: 10/679,607

Docket No.: 200400266-1

Remarks

Claims 1, 3, 6-16, and 18-24 were pending. Applicants thank the Examiner for his review of the pending claims. As set forth in the Office Action, claims 1, 3, 6, 7, and 18-20 are allowed and claims 8-16 and 21-24 stand rejected.

No claims have been canceled, amended, or added in this paper. Claims 2, 4, 5, and 17 were previously canceled. Therefore, claims 1, 3, 6-16, and 18-24 remain pending. Applicants respectfully request reconsideration of claims 8-16 and 21-24 based on the following remarks.

Allowance of Claims 1, 3, 6, 7, and 18-20

Applicants agree with the conclusion of patentability for claims 1, 3, 6, 7, and 18-20 without necessarily acquiescing to the Examiner's reasoning.

Claim Rejections Under 35 U.S.C. § 103

Claims 8-16, 21, and 24 were rejected under 35 U.S.C. 103(a) as being unpatentable over Arcaro et al. (U.S. Patent No. 6,902,643) in view of Pearson (U.S. Patent No. 6,902,643). Applicants respectfully traverse the rejection.

A. Independent Claims 8, 14, and 24

In relation to claim language reciting "a first side of a printed medium facing the heated roll" as recited in claims 8 and 24 and "the first side of the printed medium facing the heated roll" as recited in claim 14, the Examiner states:

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Arcaro et al differs from the claimed invention in that it does not disclose:

- {claim 8} a first side of a printed medium facing the heated roll
- {claim 14} the first side of the printed medium facing the heated roll
- {claim 24} the first side of the printed medium facing the heated roll
- {claims 10 and 16} that the backing roll is heated or otherwise provides energy or heat.

Pearson discloses, with respect to claims 10 and 16, that the backing roll is heated (figure 1, reference 28; if the backing roll is defined as the side that does not face the printed side).

It would have been obvious to one having ordinary skill in the art at the time the invention was made to incorporate the teachings of Pearson into the invention of modified, Arcaro et al. The motivation for the skilled artisan in doing so is to gain the benefit of assisting in the quicker drying of the printed image, thus resulting in improved printing quality. The combination naturally suggests a first side of a printed medium facing the heated roll because the combination of Arcaro et al in view of Pearson would naturally suggest that both rollers 103 and 105 of Arcaro et al would be heated (one heated roller, could be used for fusing and the other roller could be used for drying). As such, both rollers 103 and 105 could serve as both heating and backing rollers and the claimed invention would hence be met.

Office Action, page 5.

Applicants respectfully disagree. The Examiner's assertion that Pearson discloses "the backing roll is heated," as based on the interpretation, "if the backing roll is defined as the side that does not face the printed side," is in direct contradiction of the express teachings of Pearson. Pearson teaches that rolls 26 and 30, rather than roll 28, are backing rolls. See the drawings and col. 3, lines 38-24, which recite, "a print medium heating assembly including a heated roll, a first backup roll and a second backup roll, said heated roll and said first backup roll defining a first nip therebetween and said heated roll and said second backup roll defining a second nip therebetween...." Moreover, Pearson teaches that "[r]oll 28 is a heated roll...which defines a single source

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of heat for heating print medium 12 both before and after print medium 12 is printed on.” Pearson, col. 2, lines 43-47, emphasis added. Clearly, based on the express teachings of Pearson, Pearson does not disclose a heated backing roll as asserted in the Office Action. In fact, Pearson teaches away from a heated backing roll, as described above.

Accordingly, the asserted combination of Pearson and Arcaro is improper and ineffective inasmuch as it is based on an incorrect interpretation of Pearson. Because Pearson does not disclose a heated backing roll as asserted in the Office Action, the combination of Arcaro and Pearson does not include a heated backing roll. Specifically, Arcaro discloses a heat roller 105 and a pressure roller 103 forming a nip. However, Arcaro does not include any teaching or suggestion of the pressure roller 103 being heated. For the reasons described above, Pearson cannot be used to cure this deficiency. Therefore, Arcaro and Pearson fail to teach or suggest “a first side of a printed medium facing the heated roll” as recited in claims 8 and 24 and “the first side of the printed medium facing the heated roll” as recited in claim 14.

“To establish prima facie obviousness of a claimed invention, all the claim limitations must be taught or suggested by the prior art. *In re Royka*, 490 F.2d 981, 180 USPQ 580 (CCPA 1974).” M.P.E.P. § 2143.03. Accord. M.P.E.P. § 706.02(j). Therefore, for at least the reasons described above, the rejection of independent claims 8, 14, and 24 should be withdrawn.

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B. Dependent Claims 9-13, 15, 16, and 21

Claims 9-13, 15, 16, and 21 were rejected under 35 U.S.C. 103(a) as being unpatentable over Arcaro in view of Pearson. Each of claims 9-13, 15, 16, and 21 depends from independent claim 8 or 14. Therefore, for at least the same reasons described above in relation to claims 8, 14, and 24, the rejection of claims 9-13, 15, 16, and 21 should be withdrawn.

In addition, the dependent claims recite individually patentable subject matter. Merely by way of example, claims 10 and 16 recite "wherein the backing roll is heated or otherwise provides energy or heat." The Examiner relies on Pearson to reject these claim elements. Office Action, page 5. However, for the same reasons described above, Pearson teaches away from a heated backing roll. For this additional reason, the § 103 rejection of claims 10 and 16 should be withdrawn.

C. Claim 22

Claim 22 was rejected under 35 U.S.C. 103(a) as being unpatentable over Arcaro in view of Pearson and further in view of Chiba (U.S. Patent No. 4,913,991). Claim 22 depends from independent claim 8. Chiba is cited in the Office Action only for an alleged teaching of a non-wetting material and as such does not cure the deficiencies of Arcaro and Pearson described above in relation to independent claims 8, 14, and 24. Therefore, the §103(a) rejection of claim 22 should be withdrawn at least because of the dependency of the claim to independent claim 8.

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D. Claim 23

Claim 23 was rejected under 35 U.S.C. 103(a) as being unpatentable over Arcaro in view of Pearson and further in view of Nishikawa et al. (US Patent No. 7,086,727). Claim 23 depends from independent claim 8. Nishikawa is cited in the Office Action only for an alleged teaching of a fan for applying heat to a printed medium and as such does not cure the deficiencies of Arcaro and Pearson described above in relation to independent claims 8, 14, and 24. Therefore, the §103(a) rejection of claim 23 should be withdrawn at least because of the dependency of the claim to independent claim 8.

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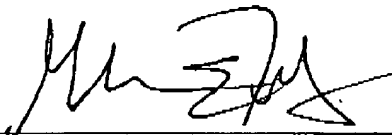
Conclusion

Reconsideration and allowance are respectfully requested. In view of the above, each of the presently pending claims in this application is believed to be in condition for allowance. Accordingly, the Examiner is respectfully requested to pass this application to issue.

Applicant believes any fee due has been addressed in the accompanying transmittal charging Deposit Account No. 08-2025, under Order No. 200400266-1 from which the undersigned is authorized to draw.

Dated: March 27, 2007

Respectfully submitted,



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